

REMARKS

By this paper, claims 1, 19, 38-41 and 43 have been amended, claims 29-37 and 45-52 have been canceled and new claims 56-60 have been added. Accordingly, claims 1-16, 18-21, 38-44 and 53-60 are pending. It is to be noted that in the Advisory Action dated November 15, 2005, it was indicated that the Amendment filed on October 25, 2005 would not be entered.

In the final Office action dated August 29, 2005, claim 1 was rejected under 35 U.S.C. § 112 as lacking sufficient antecedent basis for the recitation of "underlying vessel morphology" in claim 1. Accordingly, claim 1 has been amended to provide proper antecedent basis and as such, it is believed that the § 112 rejection has been traversed.

Additionally, in the August 2005 Office action, claims 19-21, 29, 34, 35, 37, 38, 43, 45, 51, 53 and 54 were rejected under 35 U.S.C. § 102(e) as being anticipated by Fariabi (6,419,693) and claims 41-48 were rejected under § 102(e) as being anticipated by Jalisi (6,620,192). Moreover, claims 1-9, 13, 53 and 55 were rejected under 35 U.S.C. § 103(a) as being obvious over Fariabi in view of Jalisi. In so rejecting the claims, the Examiner stated that although Fariabi does not teach a stent with a body that does not obscure underlying vessel morphology when imaged, since Fariabi discloses the same range of Tungsten as is recited in the claims, "it must inherently possess the same feature claimed in the present application."

As an initial matter, it is respectfully submitted that the Jalisi patent is not available as prior art for an obviousness rejection under 103(a). Significantly, both the present application and the Jalisi patent are assigned to Advanced Cardiovascular Systems, Inc. and the Jalisi patent only qualifies as art under § 102(e). Accordingly, the Applicants respectfully traverse the § 103(a) rejection and submit that claims 1-9, 13, 53 and 55 recite allowable subject matter.

In the November 2005 Advisory Action, the Examiner stated that "no evidence has been provided to prove that the rejection of independent claim 1 over Fariabi ...has been overcome." It is respectfully submitted, however, that since the Jalisi patent is not available for a § 103(a), the subject matter recited in claims 1-9, 13 and 55 cannot be obvious in view of the combined teachings of Fariabi and Jalisi. Moreover, it is respectfully submitted that the subject matter

recited in independent claim 1 and its dependent claims is not obvious in view of the teachings of the Fariabi patent alone. Significantly, as the Examiner has noted, there is no recognition in Fariabi of a radiopaque stent including a body which does not obscure underlying vessel morphology when subjected to imaging. It is also significant that patent case law while acknowledging inherency in an obviousness context, states that "The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency." Further, the relevant case law provides "That which may be inherent is not necessarily known" and "Obviousness cannot be predicated on what is unknown" (See MPEP 2112 and 2141.02 each citing In Re Rijckaert, 9 F.3d 1531 (Fed. Cir. 1993)). A thrust of the present application is providing a radiopaque stent which does not obscure underlying vessel morphology. On the other hand, the Fariabi patent is not concerned with such an objective. Accordingly, it is respectfully submitted that it is improper to conclude that simply including a similar range of Tungsten, the Fariabi patent must therefore "inherently possess the same feature claimed in the present application." Clearly, not obscuring vessel morphology cannot be known from the Fariabi disclosure and as such, obviousness cannot be "predicated on what is unknown" from Fariabi.

Please note that all currently pending claims except new claims 56-60 have been amended to depend from claim 1. In particular, claim 19 has been rewritten in dependent form and now claim 19 and its dependent claims 20 and 21 each depend from allowable claim 1. Similarly, the dependency of claims 38-41 and 43 has been changed so that those claims as well as their respective dependent claims (See claims 42 and 44) also depend from allowable claim 1. Furthermore, it is believed that each of the previously withdrawn claims (10-12, 14-16, 18 and 54) are now allowable due to their direct or indirect dependency from independent claim 1 since claim 1 now constitutes an allowable generic claim. Accordingly, it is believed that each of pending claims 1-16, 18-21, 38-44 and 53-55 can be passed to issue.

Moreover, it is believed that new claims 56-60 are also allowable over the cited art. Notably, the Fariabi reference does not teach, among other things, the combination of materials recited in claims 56-60.

CONCLUSION

Applicants have attempted to completely respond to the rejections set forth in the outstanding Office action. In view of the above amendments and remarks, Applicants respectfully request that the application be reconsidered, the claims allowed and the application passed to issue.

Respectfully submitted,

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